

REMARKS/ARGUMENTS

Claims 1-22 are pending in the present application. Claim 1 is canceled; claims 2-9, 13, 15, 18, and 22 were amended; and no claims were added. Applicants have amended claim 2 and cancelled claim 1 from further consideration in this application. Support for the amendments may be found in the specification at least on page 8 and 9, and figure 4.

Applicants are not conceding that the subject matter encompassed by claim 1 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 2, 9, 15, and 22 were amended and claim 1 was cancelled in this Amendment solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by claims 2, 9, 15, and 22, as presented prior to this Amendment and additional claims in one or more continuing applications. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

Applicants thank Examiner Safaipour for all the courtesies extended Applicants' representative during the March 5, 2008 and March 6, 2008 telephone interviews. During the interviews, Examiner Safaipour indicated that the above amendments to claims 2, 9, and 15 would overcome the rejection of claims 3-5, 7, and 9-21 under 35 U.S.C. 103, as well as the objection to claims 2, 6, and 8. The arguments discussed as well as additional reasons that the claims are not anticipated are set forth in the remarks below.

II. Allowable Subject Matter

Applicants thank Examiner Safaipour for indicating claim 22 is allowed and claims 2, 6, and 8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, applicants have amended claim 2 to include the limitations of base claim 1. Applicants have amended claims 3-8 to depend from claim 2. Therefore, the objections to claims 2, 6, and 8 have been overcome. Applicants believe the claims are in condition for allowance.

III. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1, 3-5, and 7 under 35 U.S.C. § 102 as being anticipated by *Antognini et al.*, System and Method for Digital Bill Presentment and Payment, U.S. Patent Publication No. 2002/0023055, February 21, 2002 (hereinafter "*Antognini*"). This rejection is respectfully traversed.

Regarding this rejection, the Examiner states:

Regarding claim 1, Antognini discloses an automatic machine, comprising:
a first input receiver for receiving input from a user (user placing paper payment instrument into the facsimile machine [0066]);
a second input receiver for receiving input from the user (user manually entering a telephone number [0066]);
a communication system capable of sending a facsimile to a remote location [0066];
wherein a user designates a facsimile number and causes a payment instrument to be sent by facsimile to the remote location [0066].

Office Action dated December 12, 2007, pp. 2-3.

Claim 1 has been canceled. In the Office Action dated December 12, 2007, the Examiner indicated that claim 2 would be allowable if rewritten in independent form. In response, claim 2 has been amended to incorporate the limitations of independent claim 1. In addition, dependent claims 3-8 are amended to depend from claim 2. Therefore, claims 2-8 are now in condition for allowance. In addition, during the interview on March 6, 2008, the Examiner agreed that the amendment to claim 2 overcomes the rejection of the claims under 35 U.S.C. 102.

IV. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 9-21 under 35 U.S.C. § 103 as being unpatentable over *Antognini*. This rejection is respectfully traversed.

Regarding this rejection, the Examiner states:

Regarding claims 9 and 15, Antognini discloses that a bill payer at ATM machine is presented with an option of paying his bills [0062]. Antognini also discloses that the ATM is capable of initiating a process where a physical check is issued and sent to the bill presented, through the mail or otherwise [0063]. Therefore if the payer selects payment via fax, the physical check can be faxed by using the method as described as "fourth choice for payment" as described in paragraph [0066].

Office Action dated December 12, 2007, p. 4.

During the interview with the Examiner on March 6, 2008, the Examiner indicated that the amendments to independent claims 9 and 15 overcome the rejection of claims 9-21 under 35 U.S.C. 103 because *Antognini* fails to teach or suggest each and every feature of amended claims 9 and 15. Claim 9 recites:

9. A method of making a payment, comprising the steps of:
requesting a payment instrument to be created by an automatic teller machine, wherein the automatic teller machine receives input for creating the payment instrument from a group consisting of a magnetic strip card, a wireless communication capable card, and cash ;
designating a payee for the payment instrument;
designating a facsimile number to form a request for a facsimile;

sending the payment instrument, by the automatic teller machine, to the payee via facsimile, wherein the facsimile is sent from the automatic teller machine located at a first location to the payee located at a second remote location; and

responsive to the automatic teller machine being incapable of sending the facsimile, forwarding the request for the facsimile via a network connection to a machine at a third remote location that is fax capable, wherein the machine at the third remote location causes the facsimile to be transmitted.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

IV.A. The proposed combination of references, considered as a whole, does not teach or suggest the feature of “sending the payment instrument, by the automatic teller machine, to the payee via facsimile,” as in claim 9.

Antognini does not teach or suggest “sending the payment instrument, by the automatic teller machine, to the payee via facsimile, wherein the facsimile is sent from the automatic teller machine located at a first location to the payee located at a second remote location”, as is recited in claim 9. The Examiner cites to *Antognini* at paragraph [0062] which states:

The third possibility in the selection of the method of preparation is to use the computerized equipment of a third party. Use of a third party's computerized equipment allows a user to take advantage of many aspects of the invention without the need to invest in or need to learn use of a computer and other equipment (e.g., a scanner and fax/modem). Third party computerized equipment in current use could be modified to better accommodate the method of bill presentment and payment. More particularly, automated teller machines ("ATM"s) maintained by banks or other entities or kiosks could be equipped with scanners so that that equipment could scan and decode the digital data printed on bills. Thus, for

example, a person receiving a series of bill containing digital data takes those bills to an ATM. After inserting a banking card and entering a PIN, consistent with current ATM protocols, a bill payer is presented with a number of choices, one of which is payment of bills. After selecting this option, the bill payer is instructed to feed the bill into the ATM's scanner, much as deposits are currently fed into ATMs now. The ATM then scans and decode the digitized bill. The ATM then asks how the bill payer wants to pay the bill, the choices including a checking or other bank account, a credit card, a debit card (including the debit card used to initiate the transaction), checks or money orders, digital or otherwise, digital prepayments (such as those discussed further below in the context of self-certifying bill payment instruments) or some other form of payment. Preferably after asking the bill payer to confirm payment of the bill, the ATM then processes the transaction, pays the bill presenter through electronic funds transfers or other methods of payment acceptable to the maintainer (e.g., the owner of the ATM, such as a bank). The ATM preferably allows payment of more than one bill at the same session. And, of course, the bill payer could also withdraw cash or proceed with some other traditional ATM transaction as part of the same ATM visit, thus allowing the bill payer to pay bills without making a special trip to the ATM.

Here, *Antognini* discloses an ATM that scans a bill and asks the bill payer how the bill payer wants to pay the bill. The ATM processes the transaction and pays the bill presenter through electronic funds. Thus, *Antognini* sends a payment by sending electronic funds. *Antognini* does not teach or suggest sending a payment instrument via facsimile.

Another portion of *Antognini* at paragraph [0063] cited by the Examiner states:

[0063] The bill payment would preferably be in a form acceptable to the bill presenter. Use of a method not acceptable to the bill presenter may contravene not only contractual restrictions but also that which is feasible. For example, the bill presenter may not provide electronic funds payment as a choice. If the maintainer of the ATM only allows payment by electronic funds transfer, the ATM maintainer may not have sufficient information (such as bill presenter bank and account information) to make the bill payment. Thus, unless the ATM maintainer has some alternative method of making payment, the payment cannot be made. One possible alternative is a backup system where the ATM initiates a process where a physical check is issued and sent to the bill presenter, through the mail or otherwise.

This portion of *Antognini* states that the ATM may initiate a process where a physical check is issued and sent to the bill presenter through mail. *Antognini* does not teach or suggest that the physical check is sent by facsimile in this or any other section of the reference. The Examiner also cites to *Antognini* at paragraph [0066] which states as follows:

[0066] The fourth choice for method of preparing a bill payment is use of a stand alone device that has some ability to execute logical instructions. Use of this type of equipment allows the bill payer to pay with some of the automation afforded by the invention while using equipment that is relatively simple to use--the complications sometimes associated with computers are largely avoided. Facsimile machines are one example of equipment in this category. The OBOS.TM. One Button Ordering System by OBOS, Inc. of Wilmington, Del. is another such type of equipment. The OBOS device allows a user to insert a piece of paper, press a button, and the device will scan the paper, place a

telephone call to a number preprogrammed into the device, and transmit an image of the scanned paper to a fax server at the other end of the telephone number. The bill payer could likewise choose a facsimile machine by placing a paper payment instrument into the facsimile machine and manually entering a telephone number, or pressing a button that recalls a telephone number, causing the facsimile machine to call the number, scan the paper and transmit an image of the scanned paper. With either the OBOS system or a facsimile machine, a fax server preferably receives the scanned image and decodes the digital information contained on that image to process the bill payment.

Here, *Antognini* describes a stand alone device, such as a facsimile machine, that may be used. A user places a paper instrument into a fax machine and causes the facsimile machine to transmit an image of the scanned paper. *Antognini* does not teach or suggest an **ATM** that sends a payment instrument via facsimile. Instead, *Antognini* only describes a stand-alone facsimile machine that may be used by a user. Thus, *Antognini* fails to teach or suggest “sending the payment instrument, by the automatic teller machine, to the payee via facsimile, wherein the facsimile is sent from the automatic teller machine located at a first location to the payee located at a second remote location”, as is recited in claim 9.

IV.B. The proposed combination of references, considered as a whole, does not teach or suggest the feature of “forwarding the request for the facsimile, by the automatic teller machine, via a network connection to a machine at a remote location that is fax capable,” as in claim 9.

Antognini fails to teach or suggest “responsive to the automatic teller machine being incapable of sending the facsimile, forwarding the request for the facsimile, by the automatic teller machine, via a network connection to a machine at a remote location that is fax capable, wherein the machine at the remote location causes the facsimile to be transmitted”, as is recited in claim 9.

As discussed above, *Antognini* teaches an ATM paying a bill presenter through electronic funds. *Antognini* does not teach or suggest an ATM sending a facsimile of a payment instrument. Moreover, *Antognini* does not teach or suggest an ATM forwarding a request for a facsimile to a machine at a remote location via a network connection when the automatic teller machine is incapable of sending the facsimile. Thus, *Antognini* fails to teach or suggest each and every feature of claim 9. Independent claim 15 recites some subject matter that is similar to the subject matter discussed above with regard to claim 9. Therefore, claim 15 is not obvious over *Antognini* for at least the reasons set forth above with regard to the similar subject matter.

Moreover, *Antognini* teaches away from the features recited in claim 9 and 15 wherein *Antognini* teaches paying a bill presenter through electronic funds without the need to invest in or need to learn use of a computer and other equipment, such as a fax/model (*Antognini* at paragraph [0062]), rather than an automatic teller machine that sends a payment instrument via facsimile and the automatic teller machine forwards a facsimile request to a machine at a remote location that is fax capable in response to the automatic teller machine being incapable of sending the facsimile.

Thus, a person of ordinary skill in the art would not be motivated to modify *Antognini* in the manner required to reach the invention in claims 9 and 15. Dependent claims 10-14 and 16-21 are not obvious in view of *Antognini* at least by virtue of their dependency on claims 9 and 15. Therefore, the rejection of claims 9-21 under 35 U.S.C. § 103 has been overcome.

V. Objection to Claims

The Examiner has stated that claims 2, 6, and 8 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, the claims have been rewritten to overcome this objection.

VI. Conclusion

It is respectfully urged that the subject application is patentable over *Antognini* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 11, 2008

Respectfully submitted,

/Mari Stewart/

Mari Stewart
Reg. No. 50,359
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants